

REMARKS/ARGUMENTS

Claims 20 - 37 are pending in the application.

Claims 20 - 28 and 36 have in effect been amended to adopt the suggestions kindly made by the Examiner and thereby avoid the 35 U.S.C. §112, second paragraph objections.

The claims stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention citing *In re Wands* (8 USPQ2d 1400 (CAFC 1988)). This rejection is respectfully traversed.

As amended, the claims are directed to a computer mediated method of genome investigation. To the extent that *In re Wands* applies to claims dealing with computer mediated genome matters, the Oberthaler and Pastor declarations rebut the Examiner's contention that undue experimentation is necessary in order to practice the invention. Both declarations clearly establish that a detailed roadmap for practicing the invention by one skilled in the art is given in the specification. Both declarations traverse the Examiner's conclusion that undue experimentation is necessary in order to practice computer mediating steps recited in the claims. The Oberthaler declaration establishes that one skilled in the art (a journeyman, molecular biologist, bioinformatician, or computer programmer who understands the storage format, content and use of readily available bioinformatics resources) can write

software following the algorithm that will analyze the DNA sequence of an organism to identify DNA sequences (called C1, C2, T1, T2 in the description of the algorithm) meeting specific criteria set forth in the description. And, further, that the identified sequences behave in such a way that when the control sequence containing C1 and C2 is transcribed into RNA, the RNA will seek out and bind to the target sequence (C1 binding to T1 and T1 and C2 binding to T2 to achieve the effect that the entire DNA sequence beginning with T1 and ending with T2 is shielded from transcription. (See page 4 of the Oberthaler declaration.)

In view of the above, applicant respectfully submits the Examiner has erred in rejecting the claims under 35 U.S.C. §112, first paragraph, and further and favorable reconsideration is respectfully requested.

Respectfully submitted,



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In the event this paper is deemed not timely filed, the applicant hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 26-0090 along with any other additional fees which may be required with respect to this paper and this application.